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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,342	12/17/2001	Andrew James Stanford-Clark	GB320000079US1	4068

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/21/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,342

Applicant(s)

STANFORD-CLARK, ANDREW
JAMES

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Acknowledgement is made of the election of Group I, claims 1-20. Applicant's election with traverse of Groups I-III, claims 1-35 in Paper No. 6 is acknowledged. The IDS is acknowledged also.

Claim Objections

1. Claim 3 is objected to because of the following informalities: "barcodes" should have a space between "bar" and "codes". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "adapted to display a first/second image" is indefinite as the phrase does not state how it is adapted, nor what this involves. Further the phrase is a process limitation, which is not considered in a product claim.
4. Claims 6 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how a second image is displayed over a second temperature range. A temperature range is usually a numerical range, and not a layer, as it appears to be referenced.
5. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. The specification is void of any teaching of materials that are "blended" to produce a first/second image. It is unclear what is intended, hence, since the first and second images are made with liquid crystals, then the Examiner takes the position that the blend consists of liquid crystals and nothing more.

6. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what process is intended; furthermore, the claim lacks antecedent basis e.g. "said image display process".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,219,625 to Matsunami et al.

9. Matsunami teaches a thermochromic laminate member and toy using the same (temperature sensitive display medium). The laminate comprises a thin transparent film on a thermochromatic layer, which has two images/zones (patterns of a first colored state and a second colored state) at col. 1, lines 22-53 which may be attached/affixed to a doll. The temperature-sensitive material in the thermochromic layer may comprise liquid crystals at col. 1, lines 60-68. At col. 2, lines 25-30, the temperature ranges changes the thermochromatic material. See also col. 3, lines 1-15, lines 40-65, which describes the light reflected colored

background and that the light is absorbed to emphasize the interference light in the background (addressing claim 9). Thermochromatic pigment (inclusive of dye) and epoxy (polymer) ink is used in Example 4 (addressing claims 10-12).

10. Regarding claim 13, the process of the image display is of no consequence. This is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

11. Regarding claims 9 and 14, the thermochromatic layer having two images may also be adjacent to each other via a back-coat layer 5 of either the first or second colored pattern/image at col. 3, line 65-col. 4, line 5.

12. Regarding claim 15, the transparent layer 3 overlays the thermochromic layer 2 at col. 3, lines 44-48.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 3 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,219,625 to Matsunami et al. in view of USPN 5,660,925 to Cooley et al.

15. Matsunami is relied upon above. Matsunami does not teach the image could be a bar code or identifier nor a transparent material intermediate a first second and/or third image.

Cooley teaches a tamper-indicating authenticating label that has a first (18) and second (20) image adjacent to each other and a transparent layer intermediate another image (22), which may also serve as the second image. The images of Cooley may be of any desired pattern, bar codes, alpha-numeric characters, logo, or the like at col. 7, lines 35-40 and 49-54. Hence it would have been obvious to one of ordinary skill in the art to modify the laminate of Matsunami to further include bar codes or identifiers for the purpose of identification as taught by Cooley at col. 7, lines 35-44. Also it would have been obvious to one of ordinary skill in the art to modify the laminate of Matsunami to include a transparent material intermediate a first, second, and/or third image because Cooley teaches such placement provides a label with security at col. 7, lines 50-55.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,329,035 to Iwasaki et al. teaches an optical display medium having a first and second layer with thermosensitive images and transparent material. USPN 6,544,925 to Prusik et al. teaches an activatable temperature indicator.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

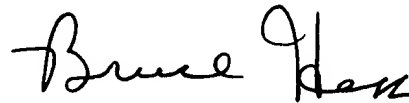
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

May 16, 2003



B. HAMILTON HESS
PRIMARY EXAMINER